

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

ROMEX TEXTILES, INC., a  
California Corporation,

Plaintiff,

v.

HK WORLDWIDE, LLC, d/b/a  
HOT KISS, a New York  
Limited Liability Company;  
APOLLO APPAREL NY, LLC, a  
New York Limited Liability  
Company; ROSS STORES, INC.,  
a Delaware Corporation; R&R  
GOLDMAN ASSOCIATES, INC.,  
d/b/a DISCOVERY CLOTHING  
COMPANY, an Illinois  
Corporation; SPECIALTY  
RETAILERS, INC., a Texas  
Corporation; BEALL'S OUTLET  
STORES, INC., a Florida  
Corporation; and DOES 1-10,  
inclusive,

Defendants.

CV 18-06543-RSWL-AGR

**ORDER re: Defendants'  
Motion for Summary  
Judgment [63]**

Plaintiff Romex Textiles, Inc. ("Plaintiff") brings  
this copyright infringement Action against Defendants

1 Apollo Apparel NY, LLC; Ross Stores, Inc.; R&R Goldman  
2 Associates, Inc., d/b/a Discovery Clothing Company;  
3 Specialty Retailers, Inc.; Beall's Outlet Stores, Inc.;  
4 and Does 1 through 10 (collectively, "Defendants").<sup>1</sup>  
5 Am. Compl., ECF No. 46. Currently before the Court is  
6 Defendants' Motion for Summary Judgment ("Motion")  
7 [63]. Having reviewed all papers submitted pertaining  
8 to this Motion, the Court **NOW FINDS AND RULES AS**  
9 **FOLLOWS:** the Court **DENIES** Defendants' Motion.

## 10 11 I. BACKGROUND

### 12 A. Factual Background

13 Plaintiff is a California corporation. Am. Compl.  
14 ¶ 4. Defendants are a series of corporations domiciled  
15 in New York, Delaware, Illinois, Texas, and Florida.  
16 Id. ¶¶ 6-10. Plaintiff is the owner and author of a  
17 two-dimensional artwork (the "Subject Design") called  
18 "AE\_T1697" under the title of work "AE Design Studio 3-  
19 31-2014". Decl. of Shawn Binafard ("Binafard Decl.")  
20 ISO Pl.'s Opp'n ¶ 4, ECF No. 67-1. On March 31, 2014,  
21 Plaintiff was granted a copyright for the Subject  
22 Design, with Registration No. VA 1-903-180. Pl.'s  
23 Opp'n, Ex. A ("Subject Design Registration"), ECF No.  
24 67-3. The Subject Design is a floral design, which is  
25 depicted below. Defs.' Mot. for Summ. J. ("Mot."), Ex.

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26  
27 <sup>1</sup> Plaintiff initially included HK Worldwide, LLC as a  
28 Defendant in this Action. HK Worldwide, LLC was dismissed  
without prejudice by stipulation on March 25, 2019. ECF No. 53.

B (the "Subject Design"), ECF No. 67-4.



Plaintiff alleges that Defendants manufactured, purchased, sold, or marketed two garments (the "Accused Designs") which infringe the Subject Design. The two allegedly infringing garments are depicted below, and entitled Version 1 and Version 2, respectively.

**Version 1**



Version 2



Mot., Ex. C ("Accused Designs"), ECF No. 63-5.

Defendants deny that they infringed the Subject Design, and bring this Motion alleging that they are entitled to judgment as a matter of law because the Subject Design and Accused Designs are not substantially similar. See generally Mot.

**B. Procedural Background**

Plaintiff filed its Complaint [1] on July 30, 2018 and then filed its Amended Complaint [46] on March 6, 2019. Defendants timely filed their Answers to the Amended Complaint [55-59], denying Plaintiff's allegations and asserting affirmative defenses, including lack of substantial similarity between the Subject Design and Accused Designs.

On May 28, 2019, Defendants filed the instant Motion for Summary Judgment [63], alleging that the Subject Design and Accused Designs are not

1 substantially similar. Plaintiff filed its Opposition  
2 on June 4, 2019 [67]. Defendants filed their Reply  
3 [68] on June 10, 2019. Plaintiff then filed a Sur-  
4 Reply [69] in support of its Opposition, in which  
5 Plaintiff filed evidentiary objections to Defendants'  
6 Reply, responses to Defendants' evidentiary objections,  
7 and a Statement of Controverted Facts. Defendants  
8 filed an Objection to Plaintiff's Sur-Reply on June 17,  
9 2019 [70].

## 10 II. DISCUSSION

### 11 A. Legal Standard

12 Summary judgment should be granted "if the movant  
13 shows that there is no genuine dispute as to any  
14 material fact and the movant is entitled to judgment as  
15 a matter of law." Fed. R. Civ. P. 56(a). A fact is  
16 "material" for purposes of summary judgment if it might  
17 affect the outcome of the suit, and a "genuine" issue  
18 exists if the evidence is such that a reasonable fact-  
19 finder could return a verdict for the nonmovant.

20 Anderson v. Liberty Lobby, Inc., 477 U.S. 244, 248  
21 (1986). The evidence, and any inferences based on  
22 underlying facts, must be viewed in the light most  
23 favorable to the nonmovant. Twentieth Century-Fox Film  
24 Corp. v. MCA, Inc., 715 F.2d 1327, 1328-29 (9th Cir.  
25 1983). In ruling on a motion for summary judgment, the  
26 court's function is not to weigh the evidence, but only  
27 to determine if a genuine issue of material fact  
28 exists. Anderson, 477 U.S. at 255.

1 Where the nonmovant bears the burden of proof at  
2 trial, the movant need only prove that there is no  
3 evidence to support the nonmovant's case. In re Oracle  
4 Corp. Secs. Litig., 627 F.3d 376, 387 (9th Cir. 2010).  
5 If the movant satisfies this burden, the burden then  
6 shifts to the nonmovant to produce admissible evidence  
7 showing a triable issue of fact. Id.; Nissan Fire &  
8 Marine Ins. Co. v. Fritz Cos., 210 F.3d 1099, 1102-03  
9 (9th Cir. 2000); see also Cleveland v. Policy Mgmt.  
10 Sys. Corp., 526 U.S. 795, 805-06 (1999) (quoting Celotex  
11 Corp. v. Catrett, 477 U.S. 317, 322 (1986)).

## 12 **B. Analysis**

### 13 1. Objections

#### 14 a. *Plaintiff's Objections*

15 Plaintiff filed several evidentiary objections to  
16 the Declarations of Edward Alfaks and Philip A. Byler.  
17 See Pl.'s Evid. Objs., ECF Nos. 67:9-10. The Court  
18 does not rely on the objected-to evidence, and thus the  
19 Court **DENIES as MOOT** Plaintiff's objections.

#### 20 b. *Defendants' Objections*

21 Defendants object to Exhibits D and E to the  
22 Declaration of Chan Yong Jeong—which contain side-by-  
23 side comparisons of specific flowers in the Subject  
24 Design and Accused Designs—on the grounds that the  
25 Exhibits are misleading since they are “black and white  
26 unclear presentations of small aspects of the larger  
27 designs at issue that do not show the larger designs.”  
28 See Defs.' Evid. Objs., ECF No. 68-7. First,

1 Defendants cite no authority for their position that  
2 the Court is unable to analyze individual aspects of  
3 the designs, and as will be discussed further, case law  
4 suggests otherwise. In any event, contrary to  
5 Defendants' assertion, Exhibits D and E contain both  
6 zoomed-in images of certain flowers in the designs and  
7 larger images of the floral patterns as a whole.  
8 Second, the images depicted in Exhibits D and E are not  
9 black and white as Defendants contend. Nonetheless,  
10 the Court acknowledges that the coloring of the images  
11 in Exhibits D and E differ from the coloring of the  
12 Subject Design as it is depicted in Plaintiff's Swatch  
13 Sheet.<sup>2</sup> However, the Court only relies on Exhibits D  
14 and E to evaluate the shape, shading, and structure of  
15 the flowers, not their color. As such, the Court  
16 **DENIES** Defendants' Evidentiary Objections.

17 Defendants also object to Plaintiff's Sur-Reply  
18 papers, in which Plaintiff responded to Defendants'  
19 evidentiary objections, asserted new evidentiary  
20 objections to evidence presented in Defendants' Reply,  
21 and filed a Statement of Disputed Facts. See ECF No.  
22 70. The Court does not rely on Plaintiff's Sur-Reply  
23 papers, and thus the Court **DENIES as MOOT** Defendants'  
24 Objection to them.

## 25 2. Analysis

26 To establish copyright infringement, Plaintiff must

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28 <sup>2</sup> Plaintiff's Swatch Sheet of the Subject Design is attached  
to Defendants' Motion as Exhibit B. See ECF No. 63-4.

1 prove "(1) ownership of a valid copyright, and (2)  
2 copying of constituent elements of the work that are  
3 original." Feist Publ'ns, Inc. v. Rural Tel. Servs.  
4 Co., 499 U.S. 340, 361 (1991). To satisfy the copying  
5 element, Plaintiff must show either "(1) that the two  
6 works in question are strikingly similar, or (2) that  
7 the works are substantially similar and that Defendants  
8 had access to the Subject [Design]." Malibu Textiles,  
9 Inc. v. Label Lane Int'l, Inc., 922 F.3d 946, 952 (9th  
10 Cir. 2019) (quotations omitted). Defendants move for  
11 summary judgment on the basis that there is no  
12 substantial similarity of the Subject Design and  
13 Defendants' designs.

14 a. *Ownership of Valid Copyright*

15 "A certificate from the U.S. Register of Copyrights  
16 'constitutes prima facie evidence of the validity of  
17 the copyright.'" Desire, LLC v. Manna Textiles, Inc.,  
18 No. CV 16-4295-DMG (JEMx), 2017 WL 5635009, at \*6 (C.D.  
19 Cal. Aug. 18, 2017) (quoting 17 U.S.C. § 410(c)).  
20 Plaintiff's design was registered with the United  
21 States Copyright Office, and thus validity of the  
22 copyright is presumed. See Subject Design  
23 Registration. To overcome this presumption, the burden  
24 shifts to Defendants to "rebut the facts set forth in  
25 the copyright certificate." Id. (quoting United  
26 Fabrics Int'l, Inc. v. C&J Wear, Inc., 630 F.3d 1255,



1 1257 (9th Cir. 2011)). Defendants fail to do so,<sup>3</sup> and  
2 in any event, assert that their Motion for Summary  
3 Judgment is "based solely on the lack of substantial  
4 similarity between the allegedly copyrighted design and  
5 the allegedly infringing design . . . ." Defs.' Reply  
6 5:15-17, ECF No. 68. Thus, the Court turns to the  
7 copying element, and evaluates the similarity of the  
8 designs.

9 b. *Copying by Defendants*

10 "Summary Judgment is not highly favored on  
11 questions of substantial similarity in copyright  
12 cases." L.A. Printex Industries, Inc. v. Aeropostale,  
13 Inc., 676 F.3d 841, 848 (9th Cir. 2012). "Where  
14 reasonable minds could differ on the issue of  
15 substantial similarity . . . summary judgment is  
16 improper." Shaw v. Lindheim, 919 F.2d 1353, 1355 (9th  
17 Cir. 1990).

18 "In assessing whether particular works are  
19 substantially similar, or strikingly similar, this  
20 Circuit applies a two-part analysis: the extrinsic test  
21 and the intrinsic test." Unicolors, Inc. v. Urban

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22  
23 <sup>3</sup> At most, Defendants argue that the idea of a flower design  
24 is not protectable and that standard aspects of a flower design  
25 are not protectible. However, even if the idea of floral designs  
26 and certain elements of floral designs are not protectable,  
27 Plaintiff's "original selection, coordination, and arrangement of  
28 such elements is protectible." L.A. Printex Industries, Inc.,  
676 F.3d at 850 ("Because there is a wide range of expression for  
selecting, coordinating, and arranging floral elements in  
stylized fabric designs, copyright protection is broad and a work  
will infringe if it's substantially similar to the copyrighted  
work.") (quotations omitted).

1 Outfitters, Inc., 853 F.3d 980, 985 (9th Cir. 2017).

2 "The extrinsic test requires plaintiffs to show overlap  
3 of concrete elements based on objective criteria, while  
4 the intrinsic test is subjective and asks whether the  
5 ordinary, reasonable person would find the total  
6 concept and feel of the works to be substantially  
7 similar." Id. (quotations omitted). While the Court  
8 may determine whether Plaintiff has satisfied the  
9 extrinsic test, "once th[at] objective threshold is  
10 met, it is the role of the jury to make a nuanced  
11 subjective determination under the intrinsic test."  
12 Id. at 987. Thus, the Court proceeds to apply the  
13 extrinsic test.

14 i. *Identifying Protectable Elements*

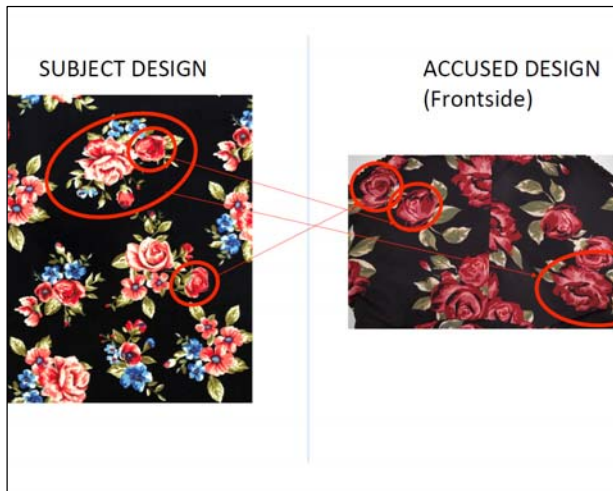
15 The first step in applying the extrinsic test is to  
16 "distinguish protectible from unprotectible elements  
17 [of a work] and ask only whether the protectible  
18 elements in two works are substantially similar." L.A.  
19 Printex Industries, Inc., 676 F.3d at 850. While the  
20 idea of a floral design or the natural appearance of  
21 the flowers themselves is not protectable, Plaintiff's  
22 "[o]riginal selection, coordination, and arrangement"  
23 of the flowers in the Subject Design is protectable  
24 expression. Id. "After all, there are gazillions of  
25 ways to combine petals, buds, stems, leaves, and colors  
26 in floral designs on fabric." Malibu Textiles, Inc.,  
27 922 F.3d at 953.

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ii. *Comparing Similarities*

Next, the Court compares the protectable elements of the Subject Design to the Accused Designs "to assess similarities in the objective details of the works." Id. (quotations omitted). "In comparing fabric designs, we examine the similarities in their objective details in appearance, including, but not limited to, the subject matter, shapes, colors, materials, and arrangement of the representations." Id.

1. *Version 1*



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1 Plaintiff identifies five "elements" of  
2 similarities between the flowers in the Subject Design  
3 and the Accused Design Version 1. Defendants dispute  
4 that the Court should consider these elements, arguing  
5 that only the Subject Design as a whole is entitled to  
6 copyright protection. While the protectable aspect of  
7 the Subject Design is the selection, coordination, and  
8 arrangement of the floral pattern, as opposed to the  
9 individual flowers themselves, the unique expressions  
10 in each flower are nonetheless relevant since they  
11 contribute to the Subject Design as a whole. For this  
12 reason, courts within the Ninth Circuit have compared  
13 both individual flowers and the works as a whole in  
14 determining substantial similarity. See, e.g., Desire,  
15 LLC v. Manna Textiles, Inc., No. CV 16-4295-DMG (JEMx),  
16 2017 WL 5635009, at \*10 (C.D. Cal. Aug. 18,  
17 2017) ("Before analyzing the Subject and Accused Designs  
18 as a whole—i.e., considering the floral design and  
19 pattern as a textile print, as opposed to the  
20 individual flowers alone—the Court evaluates the  
21 flowers individually under the extrinsic test.").  
22 Thus, the Court first compares the similarities amongst  
23 the five elements identified by Plaintiff, and then  
24 analyzes the works as a whole.

25 Element 1 highlights the largest red flower in each  
26 design. As depicted below, both the Subject Design and  
27 Accused Design contain the same three layers of petals,  
28 with each petal layer blooming outward at the same

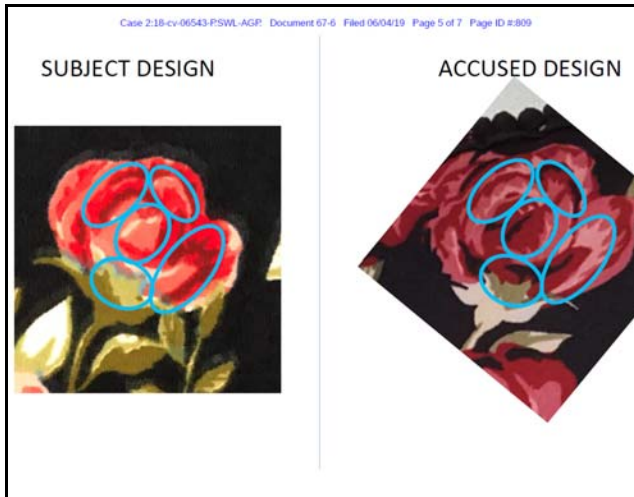
1 degree. Moreover, the shape and shading is nearly  
2 identical in each of the flower's petal layers. While  
3 the colors of shading are darker in the Accused Design,  
4 "a rational jury could find that these difference  
5 result from the fabric-printing process generally and  
6 are inconsequential." L.A. Printex Industries, Inc.,  
7 676 F.3d at 851 (quotations omitted).



16 Element 2, depicted below, refers to a mid-sized  
17 red flower in each design, which is shaped and shaded  
18 nearly identically. Additionally, both designs depict  
19 a small petal jutting toward the left at the bottom of  
20 the rosebud.



Element 3, depicted below, reveals a mid-sized red flower with nearly identical shape and shading. Moreover, each flower contains a more pronounced green ovule. The ovule is shaded similarly in both designs, with the area closest to the rosebuds shaded in one color and the lower area of the ovule shaded in a contrasting color. Next to the ovule in both designs, a leaf protrudes out to the right and curves down.



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Element 4, depicted below, reflects a three-petal flower with three curved slopes along the outer petals, and steeper slopes along the central petal, blooming outward from an asymmetrical ovule jutting toward the left. The shading in each flower, and in the ovule connected to the flower, is nearly the same.



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1 Element 5, depicted below, reflects a large, more  
2 cylindrical red flower that is shaded almost  
3 identically in both designs. The shape of the flowers  
4 is also nearly identical, with the leftmost petal  
5 jutting outward to the left and appearing taller than  
6 the rest of the flower, the rightmost petal sloping  
7 downward, and the swirl of the rose appearing the same  
8 in both.



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19 In addition to these individual similarities, a  
20 jury could find that the floral patterns as a whole are  
21 substantially similar based on the following: both  
22 depict small bouquets of red flowers resembling roses,  
23 both contain the same varying sizes and shapes of the  
24 roses, both have green leaves with short stems  
25 connecting the roses to the leaves and each other, and  
26 both contain a similar ratio between the flowers and  
27 negative space. See, e.g., Star Fabrics, Inc. v.  
28 Closet Signature Fashion Valley Mall, No. LA CV 17-



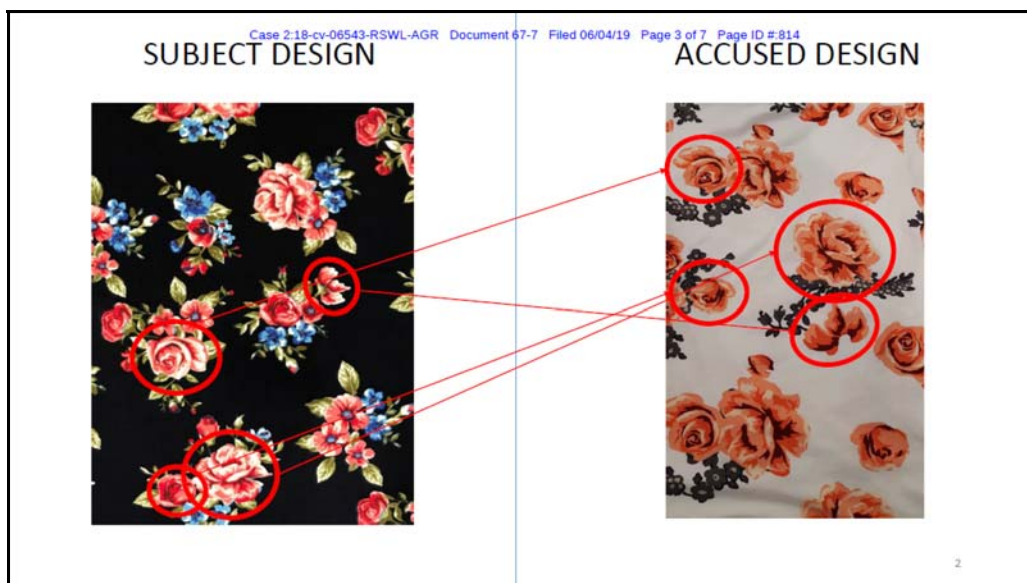
09260-JAK-FFM, 2018 WL 6265095, at \*4 (C.D. Cal. May 4, 2018) (finding substantial similarity based on the shape and texture of the flowers and the clustering of certain types of flowers, color of the flower petals and their leaves, size of the flowers and leaves, and ratio between the flowers and negative space).

Defendants dispute these similarities and focus on four alleged differences between the designs: (1) in the Subject Design most of the big red flowers have smaller yellow flowers of a different kind than the red flowers, whereas in the Accused Designs, the big flowers are not accompanied by smaller flowers of a different kind; (2) in the Subject Design, all of the big red flowers have large green leaves, whereas in the Accused Designs a majority of the big red flowers have a vine with small flowers winding away from the big flowers and some of the big flowers have no small flowers at all; (3) the Subject Design has flowers close together, whereas the Accused Designs are spread out more such that there are empty spaces without flowers; and (4) the Subject Design has a different big red flower than the Accused Designs. Mot. at 6:7-21. However, of the four listed differences, the second and third differences only pertain to Version 2 of the Accused Design. Further, the Court disagrees with Defendants as to the fourth difference in light of the similarities between the large red flowers discussed above. The Court agrees with Defendants that the first

1 difference is the most distinguishable feature of the  
2 Subject Design, and indeed, the difference may  
3 ultimately lead a jury to conclude that the two works  
4 are not substantially similar. However, at this  
5 juncture and "in light of the similarities described  
6 above, the differences support the . . . conclusion[]  
7 that there is a genuine dispute of material fact on  
8 substantial similarity." See L.A. Printex Industries,  
9 Inc., 676 F.3d at 851.

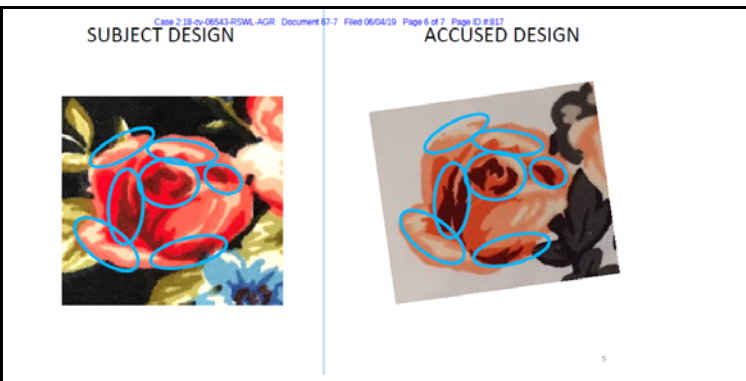
10 In sum, the Court finds that a triable issue of  
11 fact exists as to whether there is substantial  
12 similarity between the Subject Design and Version 1 of  
13 the Accused Design.

## 14 2. Version 2



26 For many of the same reasons as stated with respect  
27 to Version 1 of the Accused Design, a reasonable juror  
28 could also find that Version 2 of the Accused Design is

substantially similar to the Subject Design.  
Specifically, Version 2 contains four of the five  
“elements” of similarities that Version 1 had. Those  
four elements, depicted below, relate to the  
similarities between the largest red flowers in each  
design; the mid-sized red flowers with a small petal  
jutting toward the left at the bottom of the rosebud;  
the three-petal flower with three curved slopes along  
the outer petals and steeper slopes along the central  
petal, blooming outward from an asymmetrical ovule  
jutting toward the left; and the large, more  
cylindrical red flower that is shaded almost  
identically in both designs with the leftmost petal  
more prominent than the other petals and sloping to the  
left.





When viewed as a whole, the Subject Design and Accused Design Version 2 also contain similarities. Specifically, both designs depict small bouquets consisting of the same red flowers that resemble roses, both contain the same varying sizes and shapes of the roses, and both contain negative space between each bouquet. See Desire, LLC, 2017 WL 5635009, at \*11 (finding that where the same types of flowers were portrayed in both designs and the sizes of flowers in each design were consistent, there existed a triable issue of fact as to substantial similarity of the designs as a whole).

Despite these similarities, the Court also

1 recognizes that there are significant differences  
2 between the two works. First, the big red flowers in  
3 Version 2 of the Accused Design are not accompanied by  
4 yellow flowers or flowers of a different kind.  
5 Instead, the big red flowers are either accompanied by  
6 one other medium red flower of the same type as the  
7 large red flower, or are isolated and unaccompanied by  
8 any other flowers or leaves. Second, Version 2 of the  
9 Accused Design does not contain any green leaves or  
10 stems. Third, the flowers and bouquets in Version 2 of  
11 the Accused Design are more spread out than the  
12 bouquets depicted in the Subject Design, as the flowers  
13 are either isolated or connected to a dark grey vine  
14 with small flowers winding away from the big flowers.  
15 Fourth, the color scheme of the two designs is  
16 different. Nonetheless, as stated with respect to the  
17 differences found between the Subject Design and  
18 Version 1 of the Accused Design, these differences only  
19 further support the conclusion that a triable issue of  
20 fact exists. See L.A. Printex, 676 F.3d at 851 ("It is  
21 entirely immaterial that, in many respects, plaintiff's  
22 and defendant's works are dissimilar, if in other  
23 respects, similarity as to a substantial element of  
24 plaintiff's work can be shown.").

25 In conclusion, Defendants bear a heavy burden to  
26 establish that there is no triable issue of fact as to  
27 substantial similarity. See Rentmeester v. Nike, Inc.,  
28 883 F.3d 1111, 1127 (9th Cir. 2018) ("[Substantial

1 similarity] is an inherently factual question which is  
2 often reserved for the jury[.]"). Because a comparison  
3 of the Subject Design and the Accused Designs reveals  
4 several objective similarities and differences, the  
5 Court cannot conclude as a matter of law that the works  
6 are not substantially similar. Thus, the Court **DENIES**  
7 Defendants' Motion.<sup>4</sup>

### 8 **III. CONCLUSION**

9 Based on the foregoing, the Court **DENIES**  
10 Defendants' Motion for Summary Judgment

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12 **IT IS SO ORDERED.**

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14 DATED: August 20, 2019

s/ RONALD S.W. LEW  
**HONORABLE RONALD S.W. LEW**  
Senior U.S. District Judge

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25 <sup>4</sup> Plaintiff devotes much of its Opposition to arguing that  
26 the works are strikingly similar. However, Defendants only  
27 brought the Motion on the basis that the works lack substantial  
28 similarity. Because the Court finds a triable issue of fact as  
to substantial similarity, Defendants' Motion is denied and the  
Court need not decide whether the designs' similarities rise to  
the level of striking similarity.